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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,348	05/05/2006	Katsuhiro Sugiyama	09812.0079	5177
22852	7590	12/03/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER FANG, PAKKE	
			ART UNIT 4146	PAPER NUMBER
			MAIL DATE 12/03/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,348

Applicant(s)

SUGIYAMA ET AL.

Examiner

PAKEE FANG

Art Unit

4146

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISAC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 05/05/2006 & 01/29/2007

DETAILED ACTION

1. **Claims 1 - 6 are presented for examination.**

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in the application filed on 04/20/2006.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on 5/05/2006 & 01/29/2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

4. Figure 1 - 2 should be designated by a legend such as --Prior Art-- because both figures are used as examples to illustrate "background art". See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because the information provided is repeated in the title. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 -6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is insufficient structural evidence or support for the following means for function viewed in light of the specification, "detecting means", "changing means", & "generating means". Therefore, the examiner is examining this matter in view & in compliance with the statute 35 USC 112 6th paragraph. For the purpose of this examination "detecting means", "changing means", & "generating means" can be any structure or component which

detects, changes, and generates.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3 & 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The preamble recites "A program". A claimed "program" is clearly not a "process" under 35 U.S.C. 101 because it is not a series of steps. A claimed "program" has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine. A claimed "program" is not matter, but a form of "data structure" or "computer language instructions", and therefore is not a composition of matter. And lastly, because a "programming code" lacks physical substance and is not a residual class of product, a claimed signal does not fall within the definitions of manufacture. Therefore, a claimed signal does not constitute patentable subject matter as set forth in 35 U.S.C. 101. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

In view of the below cited MPEP section the claims are non-statutory because they are functional descriptive material per se.

MPEP 2106.01 [R-5]

Descriptive material can be characterized as either "functional

descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 6 are rejected under 35 U.S.C. 102(b) as being unpatentable over Fujita et al. (US Pub. 20040130576 A1).

In regard to claim 1, *an information processing apparatus for performing a predetermined process in accordance with an operation on a touch panel overlaid on a display, the apparatus comprising: See at least (Fujita; Fig. 2 & 5; [0026 – 0027]) - for an information*

processing device for executing predetermined instruction in accordance with a touch screen that includes a panel overlaid on a display.

detecting means for detecting a change in the aspect ratio of images to be displayed in the display; See at least (Fujita; Fig. 10; [0054 – 0056]) – for a display which can detect the change of aspect ratio of images. “In general, various aspect ratios exist for the screen portion 50 of the touchscreen display device 70, such as 16:9 or 4:3. When for example the aspect ratio of the screen portion 50 is 16:9, at least two display modes are provided.” [0054]

changing means for changing the size of each operation button to be displayed superimposed on the images See at least (Fujita; Fig. 6 & 7, item 51; [0031] & [0042 – 0043]) – for a size of each button changed and the buttons are superimposed can detect the change of aspect ratio of images on a screen. “...image combination unit 30 performs image superimposing. Specifically, the image combination unit 30 uses an overlay technique or an OSD technique to display the touchscreen of the various operation buttons superimposed on the output image screen generated by the image processor 20...” [0031]

and the size of a sensitive area of the touch panel where a user operation for the operation buttons is recognized in accordance with the detection by the detecting means; See at least (Fujita; Fig. 2 & 5, item 50; [0033– 0038]) – for a sensitive area of the display panel where a user operates the buttons is registered in accordance by the detecting sensor. “The touchscreen input portion 60 is the command input portion of the touchscreen, and includes, for example, a

touch sensor surface provided on the display panel, and a control detection circuit for the touch sensor surface...” [0033] & “...user touches a certain area on the screen portion 50, or when a user's finger or other object is brought into proximity with a prescribed position on the screen portion” [0038]

determining means for determining which operation button corresponds to the user operation on the touch panel; See at least (Fujita; Fig. 2 & 5; [0005]) – for a controller determining buttons corresponds to the user operation on the panel. “...the controller determines which of the operation buttons has been pressed (or touched), based on the positional relationship between the detected area and the display area of the operation button displayed.” [0005]

and generating means for generating a command to perform a predetermined process in accordance with the determination by the determining means, See at least (Fujita; Fig. 2 & 5; [0062 - 0066]) – for generating instructions by the command predetermined by the user in accordance with the determining mean of the controller. “...the controller 40 awaits a command from the touchscreen input portion 60, and issues instructions for the superposition display processing of the operation button image screen.” [0062]

wherein in a case where any of the operation buttons is continuously operated before and after the detection of the change in aspect ratio, See at least (Fujita; Fig. 5 - 9; [0052 - 0062]) – Fig. 6 & 7 show the operation buttons being operated before and after the detection of the change

in aspect ratio. "...first the image processor 20 changes the display mode from the wide mode to the normal mode based on an image processing control signal from the controller 40. After the change of the display mode, the normal-mode image is moved to the right side (or the left side) of the screen portion 50". [0056]

so long as the operation button to instruct a continuous process is operated before the detection of the change in aspect ratio. See at least (Fujita; Fig. 5 - 9; [0035 - 0038]) – for operation buttons instructing a process before the change in aspect ratio. "...superimposing display command from the touchscreen input portion 60 may be generated when the user touches a certain area on the screen portion 50" [0037]

the generating means generates a command to perform the continuous process corresponding to the operation button regardless of another operation button operated after the detection of the change in aspect ratio. See at least (Fujita; Fig. 5 - 9; [0035- 0038] & [0052 - 0062]) – for a controller generating means for generating a command signal immediately after the detection of an input from the touch screen; therefore, the generating means execute the command regardless of what instruction given by the buttons after the detection of the change in aspect ratio. "When the controller 40 detects that a superimposing display command is input from the touchscreen input portion 60, processing proceeds immediately to step S03." [0037] & "...the controller 40 awaits a command from the touchscreen input portion 60, and issues instructions for the superposition display processing of the operation button image screen." [0062]

Claim 2 is rejected base on the same rationale as claim 1.

Regarding Claim 3, See at least (Fujita; [0062]) – for a controller executing instructions or programs. “...controller 40... issues instructions for the superposition display processing...” [0062]. Rest of claim 3's limitation is rejected base on the same rationale as claim 1.

In regard to claim 4, *an information processing apparatus for performing a predetermined process in accordance with an operation on a touch panel overlaid on a display, the apparatus comprising*; See at least (Fujita; Fig. 2 & 5; [0026 – 0027]) - for an information processing device for executing predetermined instruction in accordance with a touch screen that includes a panel overlaid on a display.

detecting means for detecting a change in the aspect ratio of images to be displayed in the display; See at least (Fujita; Fig. 10; [0054 – 0056]) – for a display which can detect the change of aspect ratio of images. “In general, various aspect ratios exist for the screen portion 50 of the touchscreen display device 70, such as 16:9 or 4:3. When for example the aspect ratio of the screen portion 50 is 16:9, at least two display modes are provided.” [0054]

changing means for changing the size of each operation button to be displayed superimposed on the images, See at least (Fujita; Fig. 10; [0054 – 0056]) – for a display which can detect the change of aspect ratio of images. “In general, various aspect ratios exist for the

screen portion 50 of the touchscreen display device 70, such as 16:9 or 4:3. When for example the aspect ratio of the screen portion 50 is 16:9, at least two display modes are provided.” [0054]

and the size of a sensitive area of the touch panel where a user operation for the operation buttons is recognized in accordance with the detection by the detecting means; See at least (Fujita; Fig. 2 & 5, item 50; [0033– 0038]) – for a sensitive area of the display panel where a user operates the buttons is registered in accordance by the detecting sensor. “The touchscreen input portion 60 is the command input portion of the touchscreen, and includes, for example, a touch sensor surface provided on the display panel, and a control detection circuit for the touch sensor surface...” [0033] & “...user touches a certain area on the screen portion 50, or when a user's finger or other object is brought into proximity with a prescribed position on the screen portion” [0038]

determining means for determining which operation button corresponds to the user operation on the touch panel; See at least (Fujita; Fig. 2 & 5; [0005]) – for a controller determining buttons corresponds to the user operation on the panel. “...the controller determines which of the operation buttons has been pressed (or touched), based on the positional relationship between the detected area and the display area of the operation button displayed.” [0005]

and generating means for generating a command to perform a predetermined process in accordance with the determination by the determining means, See at least (Fujita; Fig. 2 & 5;

[0062 - 0066]) – for generating instructions by the command predetermined by the user in accordance with the determining mean of the controller. “...the controller 40 awaits a command from the touchscreen input portion 60, and issues instructions for the superposition display processing of the operation button image screen.” [0062]

wherein in a case where any of the operation buttons is continuously operated before and after the detection of the change in aspect ratio, See at least (Fujita; Fig. 5 - 9; [0035 - 0038]) – for operation buttons instructing a process before the change in aspect ratio. “...superimposing display command from the touchscreen input portion 60 may be generated when the user touches a certain area on the screen portion 50”[0037]

the generating means generates a command to stop a process that is being executed, See at least (Fujita; Fig. 3; [0051]) – for a command generating means release a command to turn off or stop a process which is being executed. “When the superposed display off command is confirmed at step S04, the controller 40 turns off the superposed display of the operation button image screen on the screen portion 50,” [0051]

the process corresponding to the operation button operated before the detection of the change in aspect ratio; See at least (Fujita; Fig. 3; [0045 -0055]) – for the process “the image combination unit 30 combines the source image screen 52, which is the image screen output from the image processor 20, with the operation button image screen 51 deriving from the operation input reception image signal, so as to generate a superposed display screen of the main

image and the operation button image.”[0048] is operated by command of the inputs before the change in aspect ratio.

Claim 5 is rejected base on the same rationale as claim 4.

Regarding Claim 6, See at least (Fujita; [0062]) – for a controller executing instructions or programs. “...controller 40... issues instructions for the superposition display processing...” [0062]. Rest of claim 6's limitation is rejected base on the same rationale as claim 4.

Conclusion

Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arora at cl. (US Pub. 20050097476) - The present invention is about the first set of display information indicates a portion of the video image to be displayed in a first window of a first monitor. An aspect ratio of the video image is determined based on the first set of display information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAKEE FANG whose telephone number is (571)270-7219. The examiner can normally be reached on Monday-Friday 9AM-5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patel Ramesh can be reached on (571)272-3688. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PAKEE FANG/

Examiner, Art Unit 4146

/Ramesh B. Patel/

Supervisory Patent Examiner, Art Unit 4146